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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/705,344

11/10/2003

Hidechiro Saho

36261

5170

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7590

06/09/2006

PEARNE & GORDON LLP

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CLEVELAND, OH 44114-3108

EXAMINER

GEHMAN, BRYON P

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,344

Applicant(s)

SAHO, HIDEHIRO

Examiner

Bryon P. Gehman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,7 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,7 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received. .

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/28/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12 and 13 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 12, line 7 and claim 13, lines 5-6, the phrase "pitch by pitch" is indefinite, as the term "pitch" is in reference to an angular relationship, and no individual "pitch" as a structure is defined to render the term "pitch by pitch" definite. All recessed portions and feed holes are defined to be at a constant pitch, and this in context defines one constant pitch, not several individual pitches.

In claim 12, lines 8-9, "each of the locked member attachment and locked member attachment" does not make sense.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 7 and 10-11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al. (6,389,672) in view of Busler (3,431,548). Ishii et al. disclose an electronic part supplying tape comprising multiple tape members each having a first connecting portion (one end of a series of elements 10), and a second

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connecting portion (another end of a series of elements 10), an alignment means (interengaging portions of the connecting portions 8a and 8b), and a holding means (interengaging portions of the connecting portions). Busler discloses a first connecting portion (at 44), and a second connecting portion (at 46), an alignment means (43, 44 and 48, interengaging portions of the connecting portions align the first and second members in longitudinal, width and thickness directions of the tape members), and a holding means (44 and 46), wherein the first connecting portion comprises a locking member (43) and the second connecting portion comprises a locked member (44). To modify the tape of Ishii et al. employing the connecting structure of Busler would have been an obvious substitution of connecting, aligning and holding structures already known in the art, the advantages of connecting and aligning being described by Busler. To provide the connecting portions as integral attached members as opposed to unitary members of the tape would have been an obvious modification of the structural combination, as it has been long held to provide a unitary structure in discrete elements where the elements work the same or similarly has been held to be obvious modification of an existing structure to one of ordinary skill in the art.

As to claim 7, a reel (3 or 4) is disclosed by Ishii et al. with the tape wound around it.

As to claims 10 and 11, Busler discloses the locking member (43) comprising a flat plate portion with an upstanding engaging member, the locked member (44) comprising a stepped plate portion with an engaging hole (at 44), the plate portions

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being stepped so as to not produce a stepped difference when the members are engaged.

5. Claims 12 and 13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over EP 07165260 in view of Busler (3,431,548). EP 07165260 discloses an electronic part supplying tape comprising multiple tape members each having a first connecting portion (one end of a described tape piece), and a second connecting portion (the other end of the described tape piece), an alignment means (portions K and K), and a holding means (portions received in portions K and K), the tape members each having a plurality of recessed portions (cavity parts) formed at a constant pitch and a plurality of feed holes (6) formed at a constant pitch for feeding the tape member, with the feed holes extending the entire length of the tape member. Busler discloses a first connecting portion (at 44), and a second connecting portion (at 46), an alignment means (43, 44 and 48, interengaging portions of the connecting portions align the first and second members in longitudinal, width and thickness directions of the tape members), and a holding means (44 and 46), wherein the first connecting portion comprises a locking member (43) and the second connecting portion comprises a locked member (44). To modify the tape member of EP 07165260 employing the connecting structure of Busler would have been an obvious substitution of connecting, aligning and holding structures already known in the art, the advantages of connecting and aligning being described by Busler. To provide the connecting portions as integral attached members as opposed to unitary members of the tape would have been an

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obvious modification of the structural combination, as it has been long held to provide a unitary structure in discrete elements where the elements work the same or similarly has been held to be obvious modification of an existing structure to one of ordinary skill in the art. To have the feed holes extend the entire length of the tape member would provide a feed hole in a positional relationship to a feed hole of an adjacent tape member.

6. Applicant's arguments filed May 2, 2006 have been fully considered but they are not persuasive. With respect to the combination of Ishii et al. and Busler, Ishii et al. provides the teaching of interconnecting supplying tape portions to one another. Busler discloses an old structure previously recognized to secure tape ends to one another. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references pertain to parts carrier tapes joined to one another in a manner, the manner being obvious given the teachings of Ishii et al. and Busler taken as a whole. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In*

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re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, since both prior art references pertain to joining carrier tapes, their combination is maintained to have been obvious to do to one of ordinary skill in the art.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

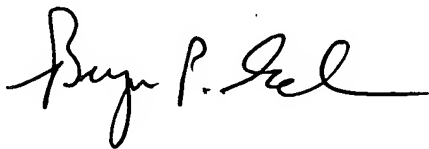
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG